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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,402	07/18/2003	Michael R. Schwarz	CS-7890	4637
34469	7590	07/09/2007		
BAYER CROPSCIENCE LP Patent Department 2 T.W. ALEXANDER DRIVE RESEARCH TRIANGLE PARK, NC 27709			EXAMINER COTTON, ABIGAIL MANDA	
			ART UNIT 1617	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/623,402	Applicant(s) SCHWARZ, MICHAEL R.	
	Examiner Abigail M. Cotton	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

This office action is in response to the remarks submitted on April 23, 2007. Claims 1-9 and 11-16 are pending in the application and are being examined on the merits herein.

Applicant's arguments filed regarding the rejections of the claims have been fully considered but they are not persuasive. The claims remain rejected for the reasons of record as follows.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 05-139921 to Suzuki et al, published June 8, 1993 (the machine translation of the JP reference is being referred to herein.)

Suzuki et al. teaches a granule for control of noxious organisms that combines 1- (6-chloro-3-pyridylmethyl)-N-nitroimidazolidine-2 indeneamine (imidacloprid, a

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chloronicotinyl insecticide) with a sulfonylurea herbicide (see abstract, in particular.)

Suzuki et al. teaches that the granule can be used to control insect pests and weeds in rice paddy fields, in particular (see abstract, in particular.) Suzuki et al. also teaches that the combination not only provides insecticidal and herbicidal activity, but that it also reduces the phytotoxicity to the plant that would otherwise be caused by the application of the herbicide (see paragraph 0009, in particular.)

Accordingly, it is considered that Suzuki et al. teaches a method of reducing phytotoxicity to a plant caused by a herbicide application to the plant comprising applying to the plant locus a composition comprising a chloronicotinyl insecticide, and applying to the plant locus a herbicidal composition that is a sulfonylurea, and thus anticipates the method of claim 1.

Regarding claims 2-3, Suzuki et al. teaches the application of the granules for the treatment of rice, which is a monocotyledon crop plant, as recited in the claims.

Regarding claims 6 and 16, Suzuki et al. teaches providing the insecticide 1-(6-chloro-3-pyridylmethyl)-N-nitroimidazolidine-2 indeneamine, which is a chloronicotinyl insecticide having the formula (I) as claimed, as well as the formula as recited in claim 16.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5, 7-9 and 11-15 are rejected under 35 U.S.C. 103(a) as being obvious over JP 05-139921 to Suzuki et al, published June 8, 1993 (the machine translation of the JP reference is being referred to herein), as applied to claims 1-3, 6 and 16 above, in view of WO 01/26468 to Senn et al, published April 19, 2001.

Suzuki et al. is applied as discussed above, and teaches the combination of the insecticide 1-(6-chloro-3-pyridylmethy)-N-nitroimidazolidine-2 indeneamine (imidacloprid, a chloronicotinyl insecticide) with a sulfonylurea herbicide for control of insects and weeds in rice paddies, as well as to reduce the phytotoxicity of the herbicide on the plants.

Suzuki et al. does not specifically teach that the herbicide is applied to the soil of the plant locus or to the foliage of the plant locus, as recited in claims 4-5. Suzuki et al. also does not specifically teach that the insecticide is applied to the seed of the plant or as a pre- or post-emergent treatment, as recited in claims 7-9. Suzuki et al. also does

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not specifically teach applying the composition to a crop plant that is maize or corn, as in claim 12, or applying to a corn seed as in claim 12, or in the amount as in claim 13. Suzuki et al. also does not specifically teach providing the soil temperature at the plant locus that is recited in claims 14-15.

Senn et al. teaches that plant growth can be improved by applying compounds having the formula (I) (see abstract, in particular), which includes the insecticide imidacloprid (see page 3, in particular), the same compound as taught by Suzuki et al. Senn et al. teaches that the compounds not only provide pesticidal activity, but also enhance plant growth (see page 4, in particular.)

Regarding claims 4-5, Senn et al. teaches that it is known to apply the insecticide/growth enhancer to the leaves of the plant (foliage) or to the soil (see paragraph bridging pages 7-8, in particular.) Regarding claims 7-9, Senn et al. teaches that it is known to apply the insecticide/growth enhancer to the seed of the plant, which is a pre-emergent treatment, as well as to the plant itself, which is a post-emergent treatment (see paragraph bridging pages 7-8 and page 8, second and third full paragraphs, in particular.)

Regarding claims 11-12, Senn et al. teaches that it is known to apply the insecticide/growth enhancer to the seeds of the plants, as discussed above, and that

suitable plants that can be treated by the insecticide/growth enhancer include cereals such as maize and rice (see page 5, first full paragraph, in particular.)

Regarding claim 13, Senn et al. teaches that the insecticide/growth enhancer can be applied in a concentration of from 0.1 to 1000 ppm (see page 7, in particular), and can also be applied at a rate of application of from 0.0005 to 1 kg per 100 kg of material to be protected (e.g., plant propagation material.) Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of the insecticide/growth enhancer composition provided to the plant locus, according to the guidance provided by Senn et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claims 14-15, Senn et al. teaches that it is known to apply the compound to the soil at the plant locus (see paragraph bridging pages 7-8, in particular), and accordingly it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to apply the composition to soil at the native or outdoors temperature of the soil, including temperatures of from 4°C to 25°C, or about 10°C to about 20°C, with the expectation of achieving insecticidal effects as well as plant growth enhancement. It is noted that "[W]here the general conditions of

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a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to apply the composition of Suzuki et al. in the methods of Senn et al, because Suzuki et al. teaches the advantages of combining an insecticide and herbicide to provide beneficial insecticidal, weed-killing and reduced phytotoxicity effects, whereas Senn et al. teaches known methods for the application and use of the insecticide used in the composition of Suzuki et al. Thus, one of ordinary skill in the art would have been motivated to provide the combination as taught by Suzuki et al, in the methods of Senn et al, with the expectation of further enhancing the methods by adding weed-killing effects with reduced phytotoxicity.

### ***Response to Arguments***

Applicants' arguments filed April 23, 2007, have been fully considered but they are not persuasive.

In particular, Applicants argue that, with regards to the rejections of the claims over Suzuki and Senn, the Examiner has used improper hindsight in constructing an obviousness rejection. The Examiner notes that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon



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hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the motivation for combining the Suzuki and Senn references lies in the fact that Suzuki et al. teaches the advantages of combining an insecticide and herbicide to provide beneficial insecticidal, weed-killing and reduced phytotoxicity effects, whereas Senn et al. teaches known methods for the application and use of the insecticide used in the composition of Suzuki et al. Thus, one of ordinary skill in the art would have been motivated to provide the combination as taught by Suzuki et al, in the methods of Senn et al, with the expectation of further enhancing the methods by adding weed-killing effects with reduced phytotoxicity.

Applicants also argue that the machine-generated translation of the Suzuki reference is inadequate as a reference because the translation is "so full of sentence fragments and gibberish, that it is not understandable" (page 11 of Remarks submitted April 23, 2007.) Applicants object to the Examiner's use of such a machine-generated translation on the basis that the MPEP does not specifically teach that such translations are suitable for use as a basis for making rejections.

The Examiner notes that machine-translated versions of Japanese patent applications are widely used by the Office in making rejections over the prior art. The

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use of these translations is highly cost-effective and efficient compared to human translations, due to their easy accessibility via the Japanese Patent Office web site. In fact, such machine-translations are the default format supplied by the USPTO translation office to Examiners requesting translations of Japanese patent documents.

The Examiner acknowledges that it is important that the machine translation be sufficiently clear such that the descriptions of compositions and/methods provided therein can be readily understood. Machine translations of Japanese documents are typically imperfect, and can often contain instances of improperly translated words, grammatically incorrect or awkward sentences, and sentence fragments. However, despite the presence of such flaws in the translations, it is considered that such machine-translations can be properly used if the content of the document taken as a whole renders the disclosure therein sufficiently clear.

In the instant case, the abstract of Suzuki clearly teaches a granule having imacloprid and a sulfonylurea herbicide to control noxious organisms such as in paddy fields. The Examiner notes that the abstract is a part of the *non machine-translated* portion of the document obtained from the Japanese Patent Office, and thus Applicants' objections to the machine-translated document are not relevant to the teachings of the abstract. Suzuki further teaches that combined composition reduced the phytotoxicity of the herbicide to paddy rice (see paragraph 0009, lines 5-6, in particular.) Accordingly, it is considered that the machine-translated version of the JP patent publication to Suzuki

is sufficiently clear to render it suitable for use as a reference in the rejections of the instant claims.

### ***Conclusion***

No claims are allowed.

The Examiner has submitted an order for a non-machine generated English translation of JP 05-139921, (as opposed to the current machine-generated translation of record), per Applicants' request. This translation will be sent to Applicants upon receipt. The English translation of another reference pertinent to the instant claims, namely JP 3-261704 to Koichi Suzuki, published November 21, 1991, is also being made of record and submitted to Applicants herewith.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMC



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